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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
08/186,469	01/26/94	ALMEIDA	A Q34367

34M1/1120
SUGHRUE, MION, ZINN, MACPEAK & SEAS
2100 PENNSYLVANIA AVE., N.W.
WASHINGTON DC 20037

EXAMINER

LEE, K

ART UNIT

PAPER NUMBER

3407

152e

DATE MAILED:

11/20/96

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☒ Responsive to communication(s) filed on October 21, 1996

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire THREE month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 2 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 2 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of Reference Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

Best Available Copy

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Part III DETAILED ACTION

1) Applicant's arguments filed October 21, 1996 have been fully considered but they are not deemed to be persuasive in view of the following reasons:

A) Claim 2 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. As stated in the prior Office action mailed August 25, 1996, claim 2 improperly recites a "gas-lift valve" in the preamble of the claim. Applicant's invention pertains to a fluid flow restrictor, not a valve member. A "valve" regulates the flow of a medium through a passage by blocking the flow entirely. A "restrictor" regulates the flow of a medium through a passage without cutting off the flow entirely. These definitions are based on more than a "mind set" of the examiner that a valve always has to be associated with a valve seat, as suggested by applicant on page 2 of the response filed February 26, 1996. These definitions are based on standard practice and custom. As applicant has stated in the response filed February 26, 1996, gas-lift valves are well known in the art. For the applicant's information, the CAMCO and McMURRY publications cited in applicant's response on February 26 are noted to each specifically disclose valve means. The specific valves disclosed

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are reverse flow check valves, similar to the check valve (36) of the gas-lift valve of Kelley et al, Patent No. 3,324,803.

Therefore, the flow devices disclosed in these publications are properly called gas-lift valves. Applicant's invention lacks valve means to block the fluid flow passage; therefore, it is improper and misleading to call the invention a "gas-lift valve." Claiming a valve and a valve seat incorrectly suggests or implies a valve member as a part of the invention. A valve seat is the structure or element in which a valve member rests in the closed position.

B) Claim 2 is rejected under 35 U.S.C. § 103 as being unpatentable over Kerr. The statute has been quoted in previous Office actions. Applicant's claim is first noted to recite in the preamble that the flow device is "for use in oil-wells." Applicant does not recite oil-well structure to limit the flow device to an oil-well environment. Therefore, the claim's preamble is considered to be a suggested use and is given no patentable weight. Secondly, applicant's flow device is not actually a valve but is instead a fluid flow restrictor. Thus, applicant's invention as claimed is reduced to a gas-lift restrictor having a venturi shape. The patent to Kerr discloses such a restrictor having a seat member (25) formed with a Venturi shape. The Venturi shape of the seat member (25) is readable as

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having a curved inlet portion and a smooth, outwardly tapered conical shaped outlet portion. A smooth, straight intermediate portion is readable in the seat member between these two inlet and outlet portions, see Exhibit A attached hereto showing the marked-up Figure 2. Kerr states that the restrictor (25) can be used with gases, col. 2, lines 75-79. It would have been an obvious design expedient to one of ordinary skill in the art at the time of the invention to have used gas as the fluid medium in the flow restrictor of Kerr.

3) **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

4) Any inquiry concerning this communication should be directed to KEVIN LEE at telephone number (703) 308-1025. The Group 3400 fax number is (703) 308-7765.

NOVEMBER 15, 1996

Kevin Lee
KEVIN LEE
PRIMARY EXAMINER
GROUP 3400

EXHIBIT A

April 28, 1931.

H. J. KERR

1,802,766

PIPE OR TUBE JOINT

Filed Dec. 8, 1927

Exhibit
A

Fig 4

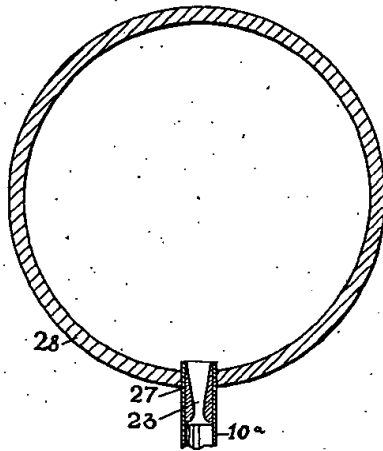


Fig 3

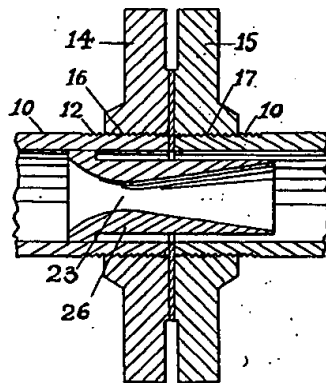


Fig 1

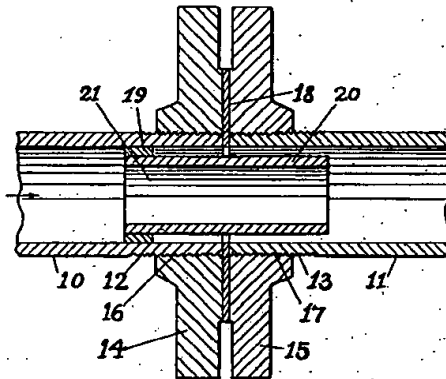
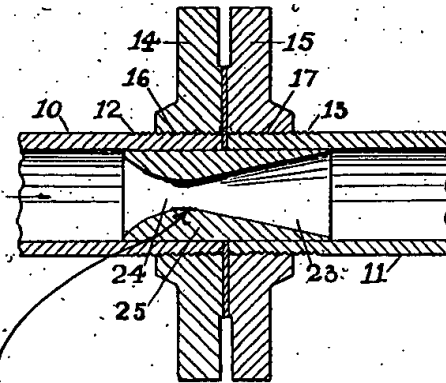


Fig 2



Smooth,
straight
intermediate
portion

INVENTOR

BY *Edward J. Kerr*
Edward J. Kerr
ATTORNEYS